

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: November 28, 2014

Opposition No. 91217436

Opposition No. 91217437

Google Inc.

v.

Hanginout, Inc.

**M. Catherine Faint,
Interlocutory Attorney:**

This case now comes up on opposer's motions, filed September 17, 2014, to suspend pending disposition of a civil action.

Consolidation

A review of the pleadings before the Board in the above-identified opposition proceedings indicates that the parties are the same and the proceedings involve substantially similar questions of fact and law. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. *See, for example*, 9A Wright &

Miller, *Federal Practice and Procedure Civ. 3d* § 2383 (Westlaw update 2014); *see also Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982).

Since the marks sought to be registered by applicant in each of its applications may have some similarities and inasmuch as opposer has in each instance challenged applicant's right of registration on the ground of priority and likelihood of confusion, it is believed that these proceedings may be presented on the same record without appreciable inconvenience or confusion. Moreover, the consolidation would be equally advantageous to both parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings individually. *See* Rule 42(a) of the Federal Rules of Civil Procedure. Further, at this point in time the judicial economy to be found in consolidation weighs in favor of such an action.

The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Res. Mgmt.*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. **91217436** as the "parent" case. As a general rule, from this point onward, only one copy of any submission should be filed herein; but that copy should include both proceeding numbers in its caption in ascending order.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; and a copy of the decision shall be placed in each proceeding file.

Suspension for Civil Action

Opposer seeks suspension of these Board proceedings pending disposition of a civil action in the United States District Court for the Southern District of California, styled as *Hanginout, Inc. v. Google, Inc.*, Civil Action No. 3:13-CV-02811-AJB-NLS. Opposer provided copies of papers from the civil action including the first amended complaint, the District Court's order denying a preliminary injunction, and the answer.

Applicant provided copies of documents filed in the civil action including a motion to dismiss and a scheduling order. Applicant argues¹ that the Board's discretion to suspend for the civil action "has not been triggered" because the District Court action alleges "only" a claim for infringement of an unregistered mark, rather than a registered one, and the District Court's order denying the preliminary injunction holds that market penetration is a required element of a claim for infringement of an unregistered mark. Applicant argues that the District Court's ruling on the preliminary injunction has determined the issue of priority in applicant's favor, and thus it is no longer an issue. Further, applicant

¹ Applicant's response briefs do not comply with Trademark Rule 2.126 which requires that submissions to the Board be double-spaced. Applicant's response briefs are single spaced. Strict compliance with the Board's rules will be expected in all of applicant's future filings with the Board.

argues, even if the Board's discretion was triggered, suspension should be denied because it "avoids a great and unwarranted injustice" as a potential bar to applicant's ability to receive statutory damages in the District Court civil action.

In reply, opposer points out that applicant's argument completely ignores the issue of likelihood of confusion raised in the civil action, and in these Board proceedings, and misrepresents the scope of what remains at issue in the District Court proceeding, including the date by which either party may have acquired common law rights in its trademark.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may have a bearing on the Board case. *See* Trademark Rule 2.117(a). Suspension of a Board proceeding pending the final determination of another proceeding is solely within in the Board's discretion. TBMP § 510.02(a). The civil action includes claims of trademark infringement which very likely have a direct bearing on the likelihood of confusion claims before the Board and could be dispositive of those issues.²

Accordingly, opposer's motion is **granted** and proceedings are suspended pending final disposition of the civil action between the parties.

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board and call this case up for any

² If the District Court elects to suspend the civil action to await determination of this Board proceeding, the parties may file an appropriate motion for resumption.

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appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.
